

li



**UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

6

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
-----------------	-------------	----------------------	---------------------

09/273,102 03/19/99 GLASSMAN

S 3765

┌

000758
FENWICK & WEST LLP
TWO PALO ALTO SQUARE
PALO ALTO CA 94306

TM02/0921

└

EXAMINER

FELTEN, D	
ART UNIT	PAPER NUMBER

2164
DATE MAILED:

09/21/01

9

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

6

Office Action Summary

Application No.
09/273,102

Applicant(s)

Glassman et al

Examiner

Daniel Felten

Art Unit

2164



— The MAILING DATE of this communication appears on the cover sheet with the correspondence address —

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Jul 12, 2001
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3-6, 11-17, and 19-22 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 3-6, 11-17, and 19-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirements.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892) 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 20) ☐ Other: _____

DETAILED ACTION

1
2 1. Receipt is acknowledged of the amendment filed July 12, 2001 amending claims 3-6,
3 11, 17, 19 and 21, canceling claims 1-2, 7-10 and 18, and adding claim 22. Claims 3-6, 11-
4 17 and 19-22 are now pending and are presented to be examined upon their merits.
5
6

Response to Arguments

7
8 2. Applicant's arguments with respect to claims 3-6, 11-17 and 19-22 have been
9 considered but are moot in view of the new ground(s) of rejection.
10

Claim Rejections - 35 USC § 103

11
12 3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all
13 obviousness rejections set forth in this Office action:

14 (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
15 section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
16 such that the subject matter as a whole would have been obvious at the time the invention was made to a person
17 having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the
18 manner in which the invention was made.
19

1 4. Claims 11-17 and 19-21 are rejected under 35 U.S.C. 103(a) as being unpatentable
2 over Hiroya et al (EP 0848 343 A2) in view of Chaum (US 5,373,558).

3
4 **Regarding claims 11-14:**

5 Hiroya et al discloses, as in claim 11, a method of providing a refund in an electronic
6 commerce system, comprising the steps of:

7 receiving, by a second party from a first party, electronic currency for which the first party
8 seeks a refund, wherein the electronic currency includes a first value derived from information
9 identifying the first party;

10 receiving, by the second party from the first party, the information identifying the first
11 party and instructions for deriving the first value from the identifying information;

12 using, by the second party, the instructions for deriving the first value from the
13 identifying information to derive a second value from the provided information identifying the
14 first party;

15 comparing, by the second party, the second value with the first value; and enabling, by the
16 second party, a refund for the electronic currency if the first value matches the second value (see
17 Abstract; and col. 11, line 9 to col. 15, line 8);

18 Hiroya et al further discloses the use of digital signatures to sign a repayment request
19 message to certify that the purchaser coincides with the payment requester (see Hiroya col. 11, ll.

1 46+), but fails to disclose wherein the second party is unable to identify the first party with
2 the first value.

3 Chaum discloses a means for signing wherein the second party is unable to identify the
4 first party with the first value (Chaum, Abstract; and col. 7, ll. 45-55). It would have been
5 obvious to an artisan of ordinary skill at the time of the invention of Hiroya to integrate the
6 method of signature (or transaction) anonymity as taught in Chaum because an artisan of ordinary
7 skill in the art would recognize the advantages of customer anonymity while making transactions
8 or purchases to protect the spending habit data of its customers from being misused or solicited
9 by third parties. Furthermore, "Anonymous transactions" are seen as notoriously old and well
10 known within the art inasmuch as "cash" transactions are conventionally use by customers to
11 protect their personal identification. Thus such a modification would have provided an obvious
12 expedient to one of ordinary skill in the art.

13
14 as in 12, Hiroya in view of Chaum discloses wherein the step of receiving the information
15 identifying the first party and instructions for deriving the first value from the identifying
16 information comprises the steps of receiving, by the second party, information uniquely
17 identifying the first party receiving, by second party, at least one nonce with which the
18 information uniquely identifying the first party is hashed to produce the second value (see
19 Hiroya, Abstract; and col. 1, lines 33-35);

1 as in claim 13, Hiroya in view of Chaum discloses wherein the information identifying
2 the first 2 party includes a predetermined value (*see, Hiroya, hashed value*, col. 1, lines 35-47);

3 as in claim 14, Hiroya in view of Chaum discloses wherein the predetermined value is a
4 text string (*see Hiroya, digital signature*, col. 1, lines 33-35).

5
6 **Regarding claims 15 and 16:** Hiroya et al in view of Chaum further discloses, as in
7 claim 15, further comprising the steps of: issuing, by the second party to the first party, a refund
8 coupon entitling the first party to a refund for the electronic currency (*see Hiroya*, col. 12, line 38
9 to col. 13, line 34).

10 as in claim 16, further comprising the steps of receiving, by a third party from the first
11 party, the refund coupon and the electronic currency for which the first party seeks a refund;
12 receiving, by the third party from the first party, an identification value for electronic
13 currency previously issued by the third party; and issuing, by the third party to the first party,
14 electronic currency having the provided identification value (*see Hiroya*, col. 13, line 41 to col.
15 14 line 48).

16
17 **Regarding claim 17:**

18 Hiroya et al in view of Chaum further discloses a computer readable medium 83 (receipt)
19 having computer instructions encoded thereon for directing a computer system to provide a

1 refund in an electronic commerce system, the computer instructions comprising instructions for
2 (see Hiroya, col. 11, lines 11-20):

3 receiving a request to refund electronic currency, the electronic currency including a value
4 identifying the party to whom the currency was issued (see Hiroya, col. 12, lines 33-49);

5 receiving, **from the party seeking the refund**, identifying information identifying the
6 party seeking the refund **and** (see Hiroya, col. 11, ll. 46 to col. 12, ll. 49);

7 verifying that the received identifying information matches the value in the electronic
8 currency identifying the party to whom the electronic currency was issued (see Hiroya, col. 12,
9 lines 6-14); and

10 responsive to a positive verification, entitling the party to whom the electronic currency
11 was issued to a refund for the electronic currency (see Hiroya, col. 11, 46-55; col. 12, lines 38-
12 49);

13
14 as in claim 19, the computer readable medium wherein the instructions for receiving
15 values comprise instructions for: receiving one or more nonces with which the information
16 identifying the party seeking the refund is hashed to produce the value identifying the party to
17 whom the currency was issued (see Hiroya, col. 11, lines 21-29);

18 as in claim 20, the computer readable medium wherein the instructions for entitling the
19 party to whom the currency was issued to a refund for the electronic currency comprise
20 instructions for:

1 issuing a refund coupon to the party seeking the refund;
2 wherein the party seeking the refund can use the refund coupon to refund the electronic
3 currency at a party who issued the electronic currency (see col. 13, lines 1-16);
4 as in claim 21, the computer readable medium further comprising instructions for:
5 receiving electronic currency containing a first value identifying the party to whom the
6 currency was issued;
7 hashing the first value identifying the party to whom the currency was issued
8 with a nonce to form a second value identifying the party to whom the currency was issued; and
9 issuing electronic currency incorporating the second value identifying the
10 party to whom the currency was issued; wherein the received request to refund electronic
11 currency comprises a request to refund the electronic currency incorporating the second value
12 (see Hiroya, col. 14, line 37 to col. 15, line 8).

13
14
15 5. Claim 22 and 3-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over
16 Manasse (US 5,802,497) in view of Hiroya (EP 0 848 343).

17 **Regarding claim 22:**

18 Manasse discloses a first system 110 (broker system) for issuing scrip, the scrip including
19 a value derived from an identification of a recipient of the scrip (see col. 2, lines 56-65; and col.
20 3, lines 34-44); and

1 a second system 130 (consumer system) for receiving the scrip issued by the first system
2 and issuing a refund in response thereto, the second system further adapted to receive the
3 identification and issuing a refund in response thereto, the second system further adapted to
4 receive from the party seeking the refund the identification of the recipient of the scrip into the
5 value derived from the identification of the recipient of the scrip, and to utilize the received
6 information to verify that the party seeking the refund is the recipient of the scrip

7 Manasse fails to disclose wherein the scrip issued by the first system **from a party**
8 **seeking a refund** and issuing a refund in response thereto, the second system further adapted to
9 receive **from party seeking the refund** the identification and issuing a refund in response
10 thereto.

11 Hiroya discloses the aforementioned feature (see Hiroya col. 11, ll. 46 to col. 12, ll. 49).
12 Electronic refunds, and verification of transactions are conventional features utilized in the art,
13 particularly in electronic wallets or credit cards, where electronic funds may be re-accredited/re-
14 issued to an account because of a discount, rebate, coupon, or unsatisfactory purchase of a good
15 or service. Therefore, it would have been obvious for an artisan of ordinary skill in the art at the
16 time of the invention of Manasse to integrate the refund of electronic money feature found in
17 Hiroya because an artisan at the time of the invention of Manasse would have recognized the
18 refund feature would provide an added convenience and satisfaction to the customer by allowing
19 automatic repayment of electronic currency without having to travel distances, wait in lines, or

1 provide addition identification. Thus such a modification would have constituted an obvious
2 expedient to one of ordinary skill in the art.

3
4 **Regarding claims 3-6:** Manasse in view of Hiroya et al further disclose, as in claim 3,
5 the third system is adapted to store one or more nonces utilized to create the value in the scrip
6 identifying the recipient of the scrip (see Manasse, fig. 4, col. 4, lines 49-57);

7 as in claim 4, wherein the first system is adapted to receive information identify the
8 recipient of the scrip prior to issuing the scrip to the recipient (see definition of a *scrip*; also
9 Manasse, col. 3, lines 34-44);

10 as in claim 5, wherein the first system is further adapted to hash the received information
11 identifying the recipient with a nonce and store the hash in the issued scrip;

12 as in claim 6, wherein the received information identifying the recipient is a hash of
13 identifying information with a second nonce (see Hiroya, col. 1, ll. 28 to col. 2, ll. 4).

14
15
16 **Conclusion**

17 6. A list of cited references appears below not relied upon in this Office Action:

18 Jones et al (US 5,623,547; US 5,440,634; and WO 91/16691) discloses an anonymous value
19 transfer system between electronic purses.

20 Chaum (US 5,373,558) discloses a designated-confirmer signature that allows the confirmer to
21 stay anonymous.

1 Kravitz (US 6,029,150) discloses a payment and transactions in electronic commerce system.

2
3 7. Any inquiry concerning this communication or earlier communications from the examiner
4 should be directed to ***Daniel S. Felten*** whose telephone number is (703) 305-0724. The
5 examiner can normally be reached between the hours of 7:00AM to 5:30PM Monday-Thursday.
6 Any inquiry of a general nature relating to the status of this application or its proceedings should
7 be directed to the Customer Service Office (703) 306-5631, or the examiner's supervisor
8 ***Vincent Millin*** whose telephone number is (703) 308-1065.

9
10
11
12 8. Response to this action should be mailed to:

13
14 Commissioner of Patents and Trademarks

15 Washington, D.C. 20231

16
17 for formal communications intended for entry, or (703) 305-0040, for informal or draft
18 communications, please label "Proposed" or "Draft".

19 Communications via Internet e-mail regarding this application, other than those under 35
20 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be
21 addressed to [*daniel.felten@uspto.gov*].

22 All Internet e-mail communications will be made of record in the application file. PTO
23 employees do not engage in Internet communications where there exists a possibility that
24 sensitive information could be identified or exchanged unless the record includes a properly
25 signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly

Serial Number: 09/273,102


Applicant(s): Glassman (705/35)

Page 11

Art Unit: 2165

Representative: Hoffman (39,713)

1 set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and
2 Trademark on February 25, 1997 at 1 195 OG 89.

3
4
5
6
7 
8 **Daniel S. Felten**
9 **September 13, 2001**


VINCENT MILLIN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100